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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,185	06/26/2003	David L. Patton	83891BF-P	5366

7590 01/24/2007

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EXAMINER	
REESE, DAVID C	
ART UNIT	**PAPER NUMBER**
3677	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/607,185	PATTON ET AL.	
	Examiner	Art Unit	
	David C. Reese	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In view of the appeal brief filed on 11/6/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Status of Claims

- Claims 1, 4-6 are pending.

Claim Objections

[1] Claim(s) 4 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 11/1/2006. Accordingly, the objection(s) to the claim(s) 4 have been withdrawn.

Claim Rejections - 35 USC § 103

[2] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[3] Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, US- 6,187,213 in view of case law, in further view of Weir, US-6,710,943 (evidence), and in even further view of applicant's own disclosure.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Smith discloses: a gemstone having a micro-discrete indicia formed thereon wherein said micro-discrete indicia image was formed using optics (Col.1, Ln. 57-67; Col.2, Ln. 1-20), wherein said micro-discrete indicia image has a length no greater than about 10 microns (Col. 3, Ln. 12-17; Coil.4, Ln. 60-65; Col. 5, Ln. 1-5; Col. 10, Ln. 59; the character line is interpreted as the indicia, as opposed to the whole character) and a height of about 50 microns (col. 4, line 63, "but that can be varied as appropriate" col. 4, line 65).

The difference between the claim and Smith is that Smith does not expressly state of using near-field optics; the height of the indicia being no greater than about 2 microns; and said gemstone having an altered color at the location of said micro-discrete indicia. First and foremost, the use of near field optics to make the image is a process step in a product claim and holds little patentable weight. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe,*

777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman, 489 F2d 742, 180 USPQ 324 (CCPA 1974).* Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug, 333 F.2d 905, 142 USPQ 161 (CCPA 1964).*

Secondly, with respect to the height of indicia found on the gemstone, the court has held that a change in the size of a prior art device is a design consideration within the skill of the art. Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose, 105 USPQ 237 (CCPA 1955).*

Further, to help show that a change in size of a prior art device is a design consideration within the skill of one in the art, Weir has been provided in the instant case as evidence teaching that the text height of indicia found on a gemstone can indeed be smaller than that expressly disclosed by Smith above. Thus, in view of Smith's size teaching, including that of the size of indicia being varied as appropriate, together with the evidence from Weir that "the text height...can be as small as 8 microns in height" (col. 1, lines 22-23) it thereby becomes readily apparent that such a change of size is indeed a design consideration within the skill of the art.

Lastly, with regard to the gemstone having an altered color at the location of said micro-discrete indicia, the applicant states in the disclosure that: "It is also possible to alter the color of gemstone materials as a result of the laser light beam affecting the defect concentration in the

gemstone or diamond material. **It is known to those skilled** in the defect physics of such materials that either through direct light absorption into existing defect optical absorption bands or through multi-photon absorption processes, color center can be produced in these materials."

Re: Claim 4, Smith discloses: wherein in said micro-discrete indicia is provided at a predetermined coordinates on said gemstone.

Re: Claim 5, Smith discloses: wherein said micro-discrete indicia provides information (col. 1, lines 6-16, "...producing an information mark...") with regard to said gemstone.

Re: Claim 6, wherein said information comprises any of the following:

size, type, manufacturer, retailer, owner, producer, country of origin, mine (col. 1, lines 11-14, "...could give other information such as a quality or trademark").

Conclusion

[4] THIS ACTION IS NON-FINAL

[5] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese
Assistant Examiner
Art Unit 3677

DCR

1/21/07

ROBERT J. SANDY
PRIMARY EXAMINER